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OFFICE OF PETITIONS

In re Application of Dorfman	:	
Application No. 09/372,416	:	Decision on Petition
Filing Date: August 11, 2009	:	
For: Easily Modifiable Macro Tag for	:	
Internet Advertising	:	

This is a decision in response to papers filed July 25, 2011, which are being treated as:

1. A request under 37 C.F.R. § 1.48(c),
2. A petition under 37 C.F.R. § 1.183 requesting waiver of sections (c)(2) and (c)(3) of 37 C.F.R. § 1.48(c),
3. A petition under 37 C.F.R. § 1.183 requesting waiver of 37 C.F.R. § 1.67 and 37 C.F.R. § 1.63 to the extent they require a supplemental declaration to be executed by the inventors, and
4. A request under 37 C.F.R. § 1.48(b).

The request under 37 C.F.R. § 1.48(c) is **dismissed**.

The petition under 37 C.F.R. § 1.183 requesting waiver of 37 C.F.R. §§ 1.48(c)(2) and (c)(3) is **dismissed**.

The petition under 37 C.F.R. § 1.183 requesting waiver of 37 C.F.R. § 1.67 and 37 C.F.R. § 1.63 is **dismissed**.

The request under 37 C.F.R. § 1.48(b) is **dismissed**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are NOT permitted. The reconsideration request should include a cover letter titled "Renewed Requests under 37 C.F.R. § 1.48 and Renewed Petitions under 37 C.F.R. § 1.183." This decision is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The current sole inventor of record is Jonathan Dorfman. Petitioner seeks to delete Jonathan Dorfman as an inventor of record, and to add David William Roth as an inventor of record.

Request under 37 C.F.R. § 1.48(c)

37 C.F.R. § 1.48(c) states,

If a nonprovisional application discloses unclaimed subject matter by an inventor or inventors not named in the application, the application may be amended to add claims to the subject matter and name the correct inventors for the application. Amendment of the inventorship requires:

- (1) A request to correct the inventorship that sets forth the desired inventorship change;
- (2) A statement from each person being added as an inventor that the addition is necessitated by amendment of the claims and that the inventorship error occurred without deceptive intention on his or her part;
- (3) An oath or declaration by the actual inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43, or § 1.47;
- (4) The processing fee set forth in § 1.17(i); and
- (5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

The request does not include the statement required by 37 C.F.R. § 1.48(c)(2) or the oath or declaration required by 37 C.F.R. § 1.48(c)(3). As will be discussed, these requirements will not be waived at this time. Therefore, the request under 37 C.F.R. § 1.48(c) must be dismissed.

The Petitions under 37 C.F.R. § 1.183

37 C.F.R. § 1.183 states,

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

In general, justice will not waive the requirement for an inventor's signature on a supplemental declaration absent a showing the inventor has refused to sign the declaration or cannot be reached or located after diligent effort. The record for the instant application fails to demonstrate Petitioner has diligently attempted to contact Roth.

Petitioner appears to seek to establish a diligent effort has been made to find Roth by citing the record for another application. Petitioner states,

The Office of Petitions has previously granted waivers for these same requirements by Mr. Roth in connection with a related application, Application No. 09/216,206 (the "'206 application"). A copy of a Decision on Petition in the '206 application is attached....

Applicant respectfully requests that waivers identical to those granted in the '206 application be granted in this application without Applicant having to submit a new showing of diligent effort in search or reaching Mr. Roth.

The showing of record made in the '206 application may well be sufficient to satisfy the requirement for Petitioner to demonstrate a diligent effort was previously made to locate Roth. However, the showing of record made in the '206 application has not been made of record in this application. Therefore, the petitions under 37 C.F.R. § 1.183 cannot be granted at this time.

Any request for reconsideration of the instant decision should include a copy of all the evidence (documents and statements) filed in the '206 application in order to establish Roth could not be found or located after diligent effort.

Request under 37 C.F.R. 1.48(b)

37 C.F.R. § 1.48(b) states,

If the correct inventors are named in a nonprovisional application, and the prosecution of the nonprovisional application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the nonprovisional application, an amendment must be filed requesting deletion of the name or names of the person or persons who are not inventors of the invention being claimed. Amendment of the inventorship requires:

- (1) A request, signed by a party set forth in § 1.33(b), to correct the inventorship that identifies the named inventor or inventors being deleted and acknowledges that the inventor's invention is no longer being claimed in the nonprovisional application; and
- (2) The processing fee set forth in § 1.17(i).

The request satisfies the requirements set forth in 37 C.F.R. § 1.48(b) and the request would normally be granted. Unfortunately, the request cannot be granted at this time as a result of the dismissal of the request under 37 C.F.R. § 1.48(c).

Dofrman is currently the sole inventor of record. A sole inventor cannot be deleted as an inventor of record absent the addition of one or more other individuals as inventors of record. In other words, since Roth is not being added as an inventor at this time, Dorfman cannot be deleted as an inventor of record.

Further correspondence with respect to this matter may be submitted as follows:

By Internet: A request for reconsideration may be filed electronically using EFS Web.¹
Document Code "PET.OP" should be used if the request is filed electronically.

¹ General Information concerning EFS Web can be found at <http://www.uspto.gov/patents/process/file/efs/index.jsp>.

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
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401 Dulany Street
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Telephone inquiries regarding this communication should be directed to Petitions Attorney
Steven Brantley at (571) 272-3203.



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